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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,468	09/30/2003	Jeyhan Karaoguz	14309US02	5572
23446 7590 01/05/2009 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
RYAN, PATRICK A				
ART UNIT		PAPER NUMBER		
2427				
MAIL DATE		DELIVERY MODE		
01/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/675,468

**Applicant(s)**

KARAOGUZ ET AL.

**Examiner**

PATRICK A. RYAN

**Art Unit**

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 10/10/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This Office Action is made in response to Amendment After Non-Final Office Action ("Reply") filed October 10, 2008. Applicant has amended Claims 1, 11, and 21; no claims have been added; and no claims have been canceled. As amended, Claims 1 through 31 are presented for examination.
2. In Office Action of July 15, 2008 ("Office Action"):
3. Claims 1 through 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Oh (US PG PUB 2002/0161713 A1).

#### ***Miscellaneous***

4. Applicant is advised that the Examiner's Art Unit number has changed from 2623 to 2427. All further correspondence should be directed to Art Unit 2427.

#### ***Response to Arguments***

5. Applicant's arguments, see Reply Pages 13-18, with respect to Claims 1, 11, and 21 have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's arguments, see Reply Pages 19-20, with respect to Claims 8, 18, and 28 have been fully considered but they are not persuasive.
7. Applicant presents that the combination of Boston and Oh does not disclose or suggest the limitation of "granting permission to schedule said at least one

advertisement for display within said identified gap" because "Oh simply discloses that instead of playing the multimedia content after it is received, the user may schedule the multimedia content to be played at a desired time." Applicant further presents that "Oh does not disclose any 'identified gap'" and "is even silent as to any scheduling of advertisements with regard to identified gaps".

The Examiner submits that the Boston reference has been previously used to address the "identified gap" limitation of Claim 8, as dependent from Claim 6, and the Oh reference has been used to address the "granting permission" limitation. The Examiner has previously presented that Step 835 of Boston is a determination of whether or not it is time for a commercial break. Commercial break times, as part of Edit Schedule 815, are retrieved in Step 810 and used in Step 835 to insert a commercial at the indicated time (as Boston describes in Col. 8 Lines 52-67 and Col. 9 Lines 1-10). Therefore, Boston identifies "gaps" in the programming when a determination of a commercial break is made in Step 835 based on time information in Edit Schedule 815. In addition, the Edit Schedule 815 of Boston is shown in Fig. 12 as a program guide with the commercial breaks identified (Commercial-1 and Commercial-2, as described in Col. 12 Lines 4-32). The Examiner therefore presents that Boston teaches the limitation "identifying a gap that exists in a schedule in a channel guide displayed on said television" as recited in Claims 6, 16, and 26.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 through 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Tomsen (US Patent 7,103,908 B2).

10. In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising:

receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4);

displaying media corresponding to at least a portion of said scheduled advertisement on said television based on said scheduling (step 935 of Figure 9 described in Col. 9 Lines 55-58; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31),

Boston teaches scheduling, based on times designated by content provider, an advertisement for viewing at the user's location (step 945 of Figure 9 described in Col 9 Lines 58-61), but does not teach automatically display, without user interaction, a notification of the advertisement on said television, after said receiving of the

advertisement and scheduling based on input from a user provided after said display of said notification of said received advertisement.

In a similar field of invention, Tomsen teaches a method and system for allowing a user to save content presented in an interactive television environment and allowing a user to defer viewing of a television advertisement to a later time (Abstract). In particular, Tomsen discloses including triggers, resources, or announcements within the content stream delivered from the broadcast source, as disclosed in Col. 5 Lines 1-19. In addition, Tomsen teaches presenting an announcement automatically to a user (i.e. Indicator 404 or Prompt 502) and without the user's interaction by way of the triggers contained in the broadcast stream during the presentation of Television Commercial 402, as shown in Figs. 4 and 5; with further reference to Col. 6 Line 25—Col. 7 Line 29 and Steps 1008-1010 of Fig. 10. Since the broadcaster designates and delivers the trigger information regarding the announcement, it is the Examiner's position that the user has no influence or control on when the announcement is initially presented. Tomsen further discusses that based on the users interaction after the announcement is presented, a user can select to defer viewing of the advertisement by saving the information to Set-top Box 152 (i.e. scheduling or planning to view at a later time) so that a user can refer to it at a later time or resume the transaction (as disclosed in Col. 7 Lines 8-29; with further reference to Col. 8 Lines 10-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaches of Boston regarding the presentation of the availability of advertisement content with Tomsen's teaching of prompting a user to defer the

consumption of a television commercial. One of ordinary skill would be motivated to make this combination in order to provide the user with greater flexibility over the consumption of program content that interests them, which can increase the likelihood that the commercial will be consumed by the user (as Tomsen discusses in Col. 1 Line 51—Col. 2 Line 5).

11. In reference to claims 2 and 22, the combination of Boston and Tomsen teach a method of and processor for presenting data representative of said received advertisement (Figure 12 described by Boston in Col. 12 Lines 18-20) in an available slot in a channel guide (detailed edit schedule 1200 of Figure 12 described by Boston in Col.12 Lines 4-12).

12. In reference to claims 3 and 23, the combination of Boston and Tomsen teach a method of and processor for displaying data representative of said received advertisement where the advertisement is one or more of graphical data, textural data, audio data and video data (disclosed by Boston in Col. 2 Lines 56-65).

13. In reference to claims 4 and 24, the combination of Boston and Tomsen teach a method of and processor for establishing a user profile (Figures 3 and 4 described by Boston in Col. 5 Lines 35-67 and Col. 6 Lines 1-54) indicating at least a particular type of advertisement that is to be received (detailed edit schedules 610 described by Boston in Col. 6 Lines 60-63).

14. In reference to claims 5 and 25, the combination of Boston and Tomsen teach a method of and processor for determining whether data representative of said particular type of advertisement is within said established profile (step 840 of Figure 8 described

by Boston in Col.9 Lines 4-10); and if said data representative of said particular type of advertisement is within said established profile, receiving said particular type of advertisement (step 860 of Figure 8 described by Boston in Col.9 Lines 10-12).

15. In reference to claims 6 and 26, the combination of Boston and Tomsen teach a method of and processor for identifying a gap that exists in a schedule in a channel guide displayed on said television (step 835 of Figure 8 described by Boston in Col 8 Lines 52-67 and Col. 9 Lines 1-16; with further reference to Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32).

16. In reference to claims 7 and 27, the combination of Boston and Tomsen teach a method of and processor for scheduling at least one advertisement for display at a time corresponding to said identified gap (decision 1040 of Figure 10 described by Boston in Col. 10 Lines 44-48).

17. In reference to Claims 8, 18, and 28, the combination of Boston and Tomsen teaches a method for granting permission to schedule at least one advertisement for display within said identified gap (Boston teaches the identification of gaps in the program schedule by way of Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31. In addition, Tomsen teaches a method of granting permission to schedule an commercial presented for playback at a later time, as described in Col. 7 Lines 8-29; with further reference to Col. 8 Lines 10-56).



18. In reference to claims 11, 12, 13, 14, 15, 16, and 17, the combination of Boston and Tomsen teach a machine-readable storage having stored thereon, a computer program having at least one code section for providing an advertisement in a communication network (disclosed by Boston in Col. 25 Lines 16-25), the at least one code section being executable by a machine (disclosed by Boston in Col. 25 Lines 25-27) for causing the machine to perform the method of claims 1 through 10, as rejected above.

19. In reference to claim 21, the combination of Boston and Tomsen teach a system for providing an advertisement in a communication network (system diagram shown in Figure 6 as described by Boston in Col. 6 Lines 55-63) for causing the machine to perform the method of claims 1 through 10, as rejected above.

20. In reference to claim 31, the combination of Boston and Tomsen teach a processor that is a media management system processor (processor 3000 of Figure 30 disclosed by Boston in Col 24 Lines 1-5).

21. Claims 9, 10, 19, 20, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Oh (US PGPUB 2002/0161713 A1).

22. In reference Claims 9, 10, 19, 20, 29, and 30 the combination of Boston and Tomsen do not teach a method for offering a reward for scheduling the advertisement for display within a personal advertisement channel. In addition, Boston and Tomsen do not teach a method where said reward comprises at least one of free programming and reduced programming cost. However, Oh teaches a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental fashion dependent upon when the user elects to view the given advertisement (as disclosed in Paragraph 0054). In addition, if the user elects to view the advertisement while the multimedia content is being played, the system provides the said multimedia content for free (as disclosed in Paragraph 0054 Lines 8-12).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion and scheduling disclosed by Boston and Tomsen to incorporate a method discounting programming content based on the event of a user scheduling an advertisement to be viewed. It would be advantageous to have an advertising system that rewarded the user for scheduling an advertisement for viewing because the user would be more likely to view additional program content and related advertisements in exchange for free or reduced cost programming (as Oh describes in Paragraph 0011).

### ***Conclusion***

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2421

01/02/2009

/P. A. R./  
Examiner, Art Unit 2427  
Monday, January 05, 2009